

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGIA L. ZEHNER
and DUANE G. UITENBROEK

Appeal 2007-1560
Application 10/680,968
Technology Center 1700

Decided: August 21, 2007

Before CHUNG K. PAK, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6.

Appellants' invention relates to liner composites suitable for incorporation into disposable absorbent articles. An understanding

of Appellants' claimed invention can be gleaned from independent claim 1 which appears below:

1. A disposable absorbent article having a longitudinal centerline (70) and a lateral centerline (72), the article comprising:
 - a liquid impermeable outer cover (48);
 - a liner composite (30), the liner composite (30) including:
 - (a) an extensible, fluid permeable liner material (32) having an upper surface (36) and an opposing lower surface (38); and
 - (b) a non-tensioned elastic (34), the non-tensioned elastic (34) being associated with at least a portion of a surface (36, 38) of the liner material (32), wherein upon activation at least a portion of the liner composite (30) adjacent where the liner material (32) and the non-tensioned elastic (34) are associated is adapted to
 - (i) have a retraction capability differential of at least 10% and
 - (ii) attain a three-dimensional configuration, and
 - wherein at least that portion of the liner material (32) adjacent where the liner material (32) and the non-tensioned elastic (34) are associated is adapted to extend no less than 25%; and
 - an absorbent core (50) disposed intermediate the outer cover (48) and the liner composite (30).

The Examiner relies on the following references in rejecting the appealed subject matter:

Coles	EP 0 650 714 A1	May 3, 1995
Osborn, III	US 6,287,288 B1	Sep. 11, 2001

I. Claims 1-31 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in such a way as to enable one skilled in the art to make and/or use the invention.

The issue presented is: Whether the Examiner has established that the subject matter of claims number 1-31 meets the enablement requirements of 35 U.S.C. § 112, first paragraph? We answer this question in the negative.

The Examiner contends that the Specification does not have an enabling disclosure for the subject matter of claims number 1-31. Specifically, the Examiner states, (Answer 3), “[t]he specification as originally filed, with one skilled in the art to make the claimed invention because it does not disclose what is meant by activation, or how activation is achieved.”

The first paragraph of 35 U.S.C. § 112 requires nothing more than an objective enablement. *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). How such teaching is set forth, either by use of illustrative examples or by broad terminology, is irrelevant. *Id.* As those skilled in the art will appreciate, the Specification, pages 5-10, provides lists of suitable materials for forming the disposable absorbent articles that comprise a liner composite material. The specification discloses the action of stretching the article and retracting to original dimensions activates the liner (Specification, 8). Since Appellants' Specification contains a written description of the suitable backing materials and the action

required for activation of the liner material corresponding with the scope of the claims on appeal, compliance with the enablement requirement is presumed. *Marzocchi*, 439 F.2d at 223-24, 169 USPQ at 369-70.

It is the Examiner's burden to present adequate basis for doubting the objective truth of Appellants' statements in the Specification, i.e., to provide scientific reasoning and/or evidence as to why one of ordinary skill in the art would not have been able to make and use the full scope of the subject matter claimed based on the written description of the invention in the Specification without undue experimentation. *Id.* On this record, however, the Examiner has not carried this burden. The Examiner has not proffered any adequate scientific reasoning and/or evidence to doubt the accuracy of Appellants' statements in the Specification. (See Answer 3-6).

The Appellants point to specific portions of the Specification to address the concerns raised by the Examiner (Br. 4). Appellants specifically disclose that the combination of stretching and retracting portions of the composite material, achieved when donning the article, activates the composite (Br. 4).

The Examiner has failed to explain why the portions of the Specification identified by the Appellants would not have been suitable for a person of ordinary skill in the art to practice the full scope of the claimed subject matter.

Accordingly, we are constrained to reverse the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 1-31 as lacking an enabling disclosure for the subject matter presently claimed.

II. Claims number 1-31 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

The issue presented is: Has the Examiner established that the subject matter of claims number 1-31 meets the requirements of 35 U.S.C. § 112, second paragraph? We answer this question in the negative.

The Examiner contends that several terms and phrases such as "activated" and "adapted to" of claims number 1-31 are not clear and therefore render the claims are indefinite (Answer 6-8).

"The legal standard for definiteness [under the second paragraph of 35 U.S.C. § 112] is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is to determine whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. The definiteness of the language employed in a claim must be analyzed not in a vacuum, but in light of the teachings of the particular application. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

After consideration of the present record, we determine that a person of ordinary skill in the art would have recognized the

disputed claim language covers disposable absorbent articles that comprise a liner composite material. The claimed invention and the Specification include references to specific elements of the drawings that correspond to various aspects of the claimed invention. The Specification includes lists of representative materials suitable for use in the disposable absorbent articles (*see* Specification generally). There is nothing inherently wrong with defining some part of an invention in functional terms or based upon specified properties. The identification of properties and functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971). Thus, we determine that the claims reasonably apprise those of ordinary skill in the art of their scope. Accordingly, we reverse the Examiner's § 112, second paragraph, rejection of claims number 1-31 as indefinite.

III. Claims number 1-31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Coles alone or in view of Osborn.¹

The Examiner contends that Coles discloses an absorbent article which comprises a topsheet, a back sheet, and an absorbent core. The topsheet is permeable. The absorbent article has an elastic composite which can be attached to either the topsheet or the backsheet. Coles teaches forming an elastic composite which can be applied to various regions of the absorbent article where elasticity is desired. The elastic composite is formed by attaching the elastic in a

¹ For this ground of rejection, Appellants have grouped their arguments together. We select claim 1 as representative of the rejected claims and will limit our discussion thereto.

relaxed state, (which is equated to the claimed non-tensioned state) to another layer such as a nonwoven fabric. The elastic composite is activated by stretching (Answer 8). The Examiner recognizes that Coles does not disclose the retraction capability. The Examiner contends that Osborn teaches absorbent articles comprising extendable materials for the topsheet and/or the backsheet of the article. The Examiner concluded that it would have been obvious to one of ordinary skill in the art to have employed an extensible topsheet or backsheet in the absorbent article of Coles, motivated by the expectation that this would enhance the comfort of the wearer of the absorbent article (Answer 9).

Appellants contend that the Examiner has not provided a reference or combination of references that teach or suggest all of the claimed elements (Br. 9). Appellants contend that Coles alone and in combination with Osborn fails to teach the claimed elements of the subject invention, namely, at least the extensible fluid permeable liner material. Specifically, Appellants state:

Coles and Osborn, alone or in combination, fail to teach or suggest all of the claim limitations. . . . Of particular note, the cited Coles reference fails to teach or suggest an extensible, fluid permeable liner material, such liner material being a clearly recited element of the subject invention and necessary to practice the inventive liner composite. The Office Action recognizes that this element is missing from the Coles reference in two regards. First, the Office Action recognizes that Coles does not disclose a retraction capability differential. Second, the Office Action recognizes that Coles only discloses a layer that is generally inextensible and only extends, if at all, at most 5% across the wide range of force

between 0.5 and 5 N/cm. To compensate for these deficiencies, the Office Action proposes that even if Coles does not teach such an extensible layer, the reference of Osborn does teach the use of an extensible layer in combination with the stretchable elastic film, scrim, or other elastic element 1 taught in Coles. (Br. 9-10).

Appellants contend that Coles clearly teaches that the invention requires a stretchable elastic layer in combination with an unelongatable layer to achieve the function and objects of the Coles taught and claimed invention. Appellants further contend it would have been “clearly contrary to the Coles reference to simply substitute an extensible layer, as may be taught in Osborn, for the unextensible layer 3 required by Coles. Further, even assuming such a substitution could be properly made, which the applicants' assert cannot under the doctrine of obviousness, it is unlikely that the composite structure would function as required by Coles, namely, resulting in a retracted composite having gathers on the exterior surface” (Br. 11).

The issue presented is as follows:

Has the Examiner reasonably determined that Coles, alone or in combination with Osborn, would have led a person of ordinary skill in the art to form an absorbent article comprising a liner composite including an extendable fluid permeable liner material and a non-tensioned elastic having a portion of the liner composite that has a three-dimensional configuration and comprises a retraction capability deferential of at least 10 %, within the

meaning of 35 U.S.C. § 103? On this record, we answer this question in the affirmative.

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). “[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-337 (Fed. Cir. 2006); *see also DyStar Textilfarben GmBH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006)(“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)(“Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without

any specific hint or suggestion in a particular reference.”’’’); *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom . . .”). The analysis supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the art to combine the elements” in the manner claimed. *KSR*, 127 S. Ct. at 1731, 82 USPQ2d at 1389.

The Examiner has found that Coles describes an absorbent article that comprises all of the elements of the present invention. The Examiner recognized that Coles did not expressly describe the retraction capability differential of at least 10% as specified in the claimed invention (Answer 8-9). However, the Examiner properly asserted that it would have been obvious to a person of ordinary skill in the art to have employed an extendable topsheet or backsheet in the absorbent article of Coles (Answer 9). The Examiner cited the Osborn reference for describing extendable materials suitable for formation of the topsheet and/or backsheet of an absorbent article (Answer 9). Coles discloses the object of the invention is to provide an absorbent article by which stretchability can easily be provided in selected areas and in a selected direction and in which the degree of extendability can easily be controlled (col. 2, l. 54-col. 3, l. 1). A person of ordinary skill in the art would have understood the proper conditions for adding elastically extendable layers to composite

materials (*see* Coles and Osborn generally). While Coles may have a preference for a certain degree of stretching in which the composite layer could have been extended, this does not detract from the knowledge of persons of ordinary skill in this art who may desire an article that has further stretching capability. The Osborn reference is evidence that the selection of liner materials that provide a retraction capability differential specified by the claimed invention would have been well within the capabilities of a person of skill in this art. Contrary to Appellants' arguments, the use of materials having an elongation of at least 10% in the invention of Coles would not have destroyed Cole's intended purpose of producing an absorbent article that could easily be stretched in selected areas.

For the foregoing reasons and those presented in the Answer, the rejection of claims number 1-31 under 35 U.S.C. § 103(a) as obvious over the combined teachings of Coles and Osborn is affirmed. As a final point with respect to the § 103 rejections, we note that Appellants base no argument upon objective evidence of nonobviousness, such as unexpected results.

ORDER

The rejection of claims number 1-31 under 35 U.S.C. § 112, first and second paragraphs are reversed. The rejection of claims 1-31 under 35 U.S.C. §103 (a) is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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